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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,642	11/25/2003	George Frey	4002/3455/PC401.15	7102

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EXAMINER

BLANCO, JAVIER G

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/721,642

Applicant(s)

FREY ET AL.

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 50-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-14, 50-52, 54-56, 58-68, and 70 is/are rejected.
- 7) ☒ Claim(s) 11, 53, 57 and 69 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/25/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicants' cancellation of claims 20-49 in the reply filed on November 25, 2003 is acknowledged.
2. Applicants' addition of claims 50-65 in the reply filed on November 25, 2003 is acknowledged.
3. Applicants' cancellation of claims 15-19 in the reply filed on October 23, 2006 is acknowledged.
4. Applicants' addition of claims 66-70 in the reply filed on October 23, 2006 is acknowledged.

Election/Restrictions

5. Applicants' election without traverse of Spinal Implant: Species A (embodied in independent claims 1 and 61) in the reply filed on October 23, 2006 is acknowledged.
6. Currently, claims 1-14 and 50-70 read on the elected species.

Specification

7. The disclosure is objected to because of the following informality: please update the CROSS-REFERENCE TO RELATED APPLICATIONS section (i.e., now US 6,830,570).
Appropriate correction is required.

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Claim Objections

8. Claims 1 and 7 are objected to because of the following informalities:

a. Regarding claim 1, please substitute "anterior end wall" (see lines 7-8) with --anterior wall--.

Appropriate correction is required.

b. Regarding claim 7, please substitute "threaded holed" (see line 2) with --threaded hole--.

Appropriate correction is required.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-14 and 50-70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-97 of U.S. Patent No. 7,060,073.

Although the conflicting claims are not identical, they are not patentably distinct from each other

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because the difference between claims 1-14 and 50-70 of the application and claims 1-97 of the patent lies in the fact that the patent claims include many more elements and is thus much more specific. Thus the invention of claims 1-97 of the patent is in effect a “species” of the “generic” invention of claims 1-14 and 50-70. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1-14 and 50-70 of the application are anticipated by claims 1-97 of the patent, it is not patentably distinct from claims 1-97.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-7, 61, and 63-65 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dove et al. (US 4,904,261; cited in Applicants’ IDS).

Referring to Figures 1-6, Dove et al. disclose a spinal implant comprising:

(i) A leading end wall, the leading end wall may have an insertion tool-engaging portion (i.e., any “portion” of said end wall can be engaged by a tool);

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(ii) A trailing end wall, the trailing end wall may have an insertion tool-engaging portion (i.e., any “portion” of said end wall can be engaged by a tool);

(iii) A concave posterior wall (inner curved face 17) extending between said leading end wall and said trailing end wall;

(iv) A convex anterior wall (outer curved face 15) extending between said leading end wall and said trailing end wall;

(v) An upper bearing member (upper planar face 10) extending between and connected to said leading end wall, said anterior wall, said posterior wall, and said trailing end wall; and

(vi) An opposite lower bearing member (lower planar face 11) extending between and connected to said leading end wall, said anterior wall, said posterior wall, and said trailing end wall, wherein said posterior wall has a height that is less than (i.e., wedge-shaped or taper) a height of said anterior wall, and wherein said trailing end wall and said leading end wall each have a height that is less than the height of both said anterior wall and said posterior wall. “A height” is broadly interpreted as any height along a wall. The spinal implant comprises holes 13, 14 to receive fixation screws.

13. Claims 1-7, 61, and 63-65 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Schaefer et al. (EP 0 916 323; cited in Applicants’ IDS). For English translation, see US 6,143,032.

Referring to Figures 1-3 and 5, Schaefer et al. disclose a spinal implant comprising:

(i) A leading end wall (7), the leading end wall may have an insertion tool-engaging portion (i.e., any “portion” of said end wall can be engaged by a tool);

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(ii) A trailing end wall (6), the trailing end wall may have an insertion tool-engaging portion (instrument receptacle 19);

(iii) A concave posterior wall (5) extending between said leading end wall and said trailing end wall;

(iv) A convex anterior wall (4) extending between said leading end wall and said trailing end wall;

(v) An upper bearing member (upper face/surface) extending between and connected to said leading end wall, said anterior wall, said posterior wall, and said trailing end wall; and

(vi) An opposite lower bearing member (lower face/surface) extending between and connected to said leading end wall, said anterior wall, said posterior wall, and said trailing end wall, wherein said posterior wall has a height that is less than (i.e., wedge-shaped or taper) a height of said anterior wall (see Figure 5; see column 4, lines 7-12), and wherein said trailing end wall and said leading end wall each have a height that is less than the height of both said anterior wall and said posterior wall. "A height" is broadly interpreted as any height along a wall.

14. Claims 1, 2, 4-10, 12, 13, 50-52, 61, 62, 65, 66, and 70 are rejected under 35

U.S.C. 102(b) as being clearly anticipated by Tropiano (US 5,607,424; cited in Applicants' IDS).

Referring to Figures 1 and 2A, Tropiano discloses a spinal implant comprising:

(i) A leading end wall (16), the leading end wall may have an insertion tool-engaging portion (i.e., any "portion" of said end wall can be engaged by a tool);

(ii) A trailing end wall (18), the trailing end wall may have an insertion tool-engaging portion (threaded opening 39);

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(iii) A posterior wall (planar surface 22) extending between said leading end wall and said trailing end wall;

(iv) A anterior wall (planar surface 20) extending between said leading end wall and said trailing end wall;

(v) An upper bearing member (14) extending between and connected to said leading end wall, said anterior wall, said posterior wall, and said trailing end wall; and

(vi) An opposite lower bearing member (12) extending between and connected to said leading end wall, said anterior wall, said posterior wall, and said trailing end wall, wherein said posterior wall has a height that is less than (i.e., wedge-shaped or taper) a height of said anterior wall (see Figure 2A), and wherein said trailing end wall and said leading end wall each have a height that is less than the height of both said anterior wall and said posterior wall. "A height" is broadly interpreted as any height along a wall. The terms "anterior", "posterior", "upper", and "lower" are broadly interpreted since the claim language does not indicate points of reference (upper bearing member faces the upper vertebra; anterior wall faces the anterior side of the spinal column; etc.). Said anterior wall includes struts 50, anterior lateral openings 34, 38, and a middle opening 36. The upper and lower bearing members each includes a cantilevered portion (see Figure 1 and Figure 2A) extending beyond said anterior wall (portions of 16, 18, and struts 50 extend outward and beyond planar surface 20).

15. Claims 1, 2, 4-10, 12-14, 50-52, 54-56, 58-62, 65-68, and 70 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cottle (WO 97/15248 A1). For English translation, see US 5,888,227 A.

Referring to Figures 2-8, Cottle discloses a spinal implant comprising:

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- (i) A leading end wall (13), the leading end wall may have an insertion tool-engaging portion (i.e., any “portion” of said end wall can be engaged by a tool, or receptacle 19);
- (ii) A trailing end wall (14), the trailing end wall may have an insertion tool-engaging portion (i.e., any “portion” of said end wall can be engaged by a tool, or receptacle 19);
- (iii) A posterior wall (15) extending between said leading end wall and said trailing end wall;
- (iv) A curved/convex anterior wall (16) extending between said leading end wall and said trailing end wall;
- (v) An upper bearing member (12) extending between and connected to said leading end wall, said anterior wall, said posterior wall, and said trailing end wall; and
- (vi) An opposite lower bearing member (11) extending between and connected to said leading end wall, said anterior wall, said posterior wall, and said trailing end wall, wherein said posterior wall has a height that is less than (i.e., wedge-shaped or taper) a height of said anterior wall (see Figure 6), and wherein said trailing end wall and said leading end wall each have a height that is less than the height of both said anterior wall and said posterior wall. “A height” is broadly interpreted as any height along a wall. The anterior wall (16) comprises lateral openings 27, a middle opening 25/26, and lateral struts (each located between 27 and 28). The upper and lower bearing member further comprises an opening (24), and grooves (11) formed in surfaces thereof (see Figures). As shown in Figures 4, 5, and 8, the upper and/or lower bearing members may include at least one strut. As clearly shown in Figures 4 and 6, said upper bearing member and lower bearing member each include a cantilevered portion extending beyond said anterior wall.

16. Claims 1, 2, 4-7, 61, and 65 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Biscup (US 6,245,108; cited in Applicants’ IDS).

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Referring to Figures 1-5, Biscup discloses a spinal implant comprising:

- (i) A leading end wall (40), the leading end wall may have an insertion tool-engaging portion (i.e., any “portion” of said end wall can be engaged by a tool, or receptacle 160);
- (ii) A trailing end wall (50), the trailing end wall may have an insertion tool-engaging portion (i.e., any “portion” of said end wall can be engaged by a tool, or receptacle 160);
- (iii) A posterior wall (70) extending between said leading end wall and said trailing end wall;
- (iv) A convex anterior wall (60) extending between said leading end wall and said trailing end wall;
- (v) An upper bearing member (20) extending between and connected to said leading end wall, said anterior wall, said posterior wall, and said trailing end wall; and
- (vi) An opposite lower bearing member (30) extending between and connected to said leading end wall, said anterior wall, said posterior wall, and said trailing end wall, wherein said posterior wall has a height that is less than (i.e., wedge-shaped or taper) a height of said anterior wall (see Figures 3 and 5), and wherein said trailing end wall and said leading end wall each have a height that is less than the height of both said anterior wall and said posterior wall. “A height” is broadly interpreted as any height along a wall. The anterior wall (60) comprises lateral openings 140, a middle opening 150, lateral struts (each located between an opening 140 and an opening 160), and a middle strut (wherein middle opening 150 is located). The upper and lower bearing member further comprises an opening (100), and grooves (80) formed in surfaces thereof (see Figure 1-3).

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Allowable Subject Matter

17. Claims 11, 53, 57, and 69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:30 a.m.-7:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Javier G. Blanco

December 27, 2006



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